

REMARKS/ARGUMENTS

The rejections presented in the Office Action dated September 3, 2008, (hereinafter Office Action) have been considered but are still believed to be improper. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Applicant respectfully traverses the finality of the Office Action. The Office Action includes a new ground of rejection; specifically, Claims 5, 11-20, and 23 are now rejected based on Lewis (previously-cited) as modified by the teachings of the newly-cited references U.S. Publication No. 2002/0055343 by Stetzler *et al.* (hereinafter “Stetzler”) and WO 01/45308 to Robinson (hereinafter “Robinson”). However, MPEP § 706.07(a) states that a second action on the merits shall be final except “where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims, nor based on information submitted in an information disclosure statement”. Notably, Applicant’s previous response filed on May 22, 2008, did not include any amendments to the claims, and no information disclosure statements were filed subsequent to issuance of the first Office Action dated February 22, 2008. Since the Office Action includes a new ground of rejection citing new art for Claims 5, 11-20, and 23, but the new ground was not necessitated by claim amendments or an information disclosure statement, the MPEP requires that the Office Action shall not be made final. Applicant accordingly requests that the finality of the Office Action be withdrawn.

Applicant respectfully maintains the traversal of the prior art rejections because Lewis fails to at least teach or suggest a user terminal that communicates with both a broadcast system and a radio system, as claimed in each of the independent claims. Contrary to the assertion at page five of the Office Action, the independent claims clearly distinguish between the two claimed systems by separately identifying/reciting both systems in the claims, and the Specification clearly defines both of the systems. For example, a radio system is described at page 3, line 29 – page 4, line 35, and a broadcast system is described at page 5, line 1 *et seq.*, with parts of the broadcast system being further described under their respective separate headings. It is also noted that an applicant is entitled to be

his own lexicographer, and the specification should be relied on to determine the meaning of a claim term, including taking into account the usage of the term in the specification (*e.g.*, MPEP § 2111.01). In contrast to the asserted interpretation at the bottom of page five, a cable network fails to correspond to the claimed radio system since a cable network at least fails to utilize the network elements of the claimed radio system. As explained previously, none of the cited portions of Lewis teach or suggest sending a request for an object, associated with a received media stream, via a radio system or delivering the requested object via the radio system, as claimed. Instead, Lewis has only been shown to teach broadcasting a media stream via a broadcast system. In an effort to more clearly characterize the claimed systems, the independent claims have been amended to indicate that the radio system is a mobile radio system and that the object identification is delivered wirelessly. These limitations were already implicitly present in the independent claims, but further support for the changes may be found in the Specification at page 3, lines 29-35. Without a presentation of correspondence to each of the claimed limitations, the rejections are improper and should not be maintained.

Consistent with Lewis' failure to teach or suggest use of a radio system, as claimed, Lewis fails to teach the claimed user terminal of a radio system. Lewis teaches that an advertisement (asserted as corresponding to the claimed object identification) would be presented in a television, VCR, DVD, personal computer, or WebTV device; however, none of these devices communicates via a radio system as required by the claims. The only mention of a device that could be considered a user terminal of a radio system teaches that a VPR/DMS device may be programmed remotely using such a device in paragraph [0163]. However, there is no teaching or suggestion that such a device would present a media stream received from a broadcast system or send a transaction signal with an object identification to request delivery of an object. Thus, Lewis fails to teach or suggest a user terminal that presents a media stream and communicates through a radio system as claimed.

In addition, Lewis fails to teach or suggest that the advertisement (asserted object identification) is presented in a user terminal in synchronization with a media stream, as claimed. Rather, Lewis teaches that advertisements are received and stored at the

VPR/DMS. More specifically, the advertising data is held in buffer memory 72 until instructions are received as to a user's desires for the data, *e.g.*, storage, display, or playback (paragraph [0178]). Thus, the advertisement is presented (displayed) to a user when decided by the user, not in synchronization with an associated media stream as claimed.

Further, Lewis fails to teach or suggest sending the object identification or delivering an object through a radio system. Instead, the cited paragraphs of Lewis each refer to a broadcast system. The relied-upon data feeds deliver content via broadcast systems - the radio broadcast is delivered via a broadcast system and not the claimed radio system. Also, while Lewis teaches that a user may access (*e.g.*, rent or purchase) material using menus (paragraph [0092]), there is no indication that the user sends received advertising data (the asserted object identification) with a transaction signal in order to do so. No connection has been identified in Lewis between received advertising data and a request by a user for a data product. Without a presentation of correspondence to each of the claimed limitations, each of the rejections is improper.

With particular respect to the § 102(e) rejection, in order to anticipate a claim, the asserted reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The Federal Circuit also recently held that "Because the hallmark of anticipation is prior invention, the prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements 'arranged as in the claim.'" (*Net Moneyin, Inc. v. Verisign, Inc.*, --- F.3d ----, 2008 WL 4614511 (Fed. Cir. 2008) quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)). Therefore, all claim elements, and their limitations, must be found in the prior art reference to maintain the rejection based on 35 U.S.C. § 102. Applicant respectfully maintains that Lewis does not teach every element of at least independent Claims 1 and 21, in the requisite detail, and therefore fails to anticipate Claims 1-10, 21, 22, 24, and 25.

Dependent Claims 2-10, 22, 24, and 25 depend from independent Claims 1 and 21, and also stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Lewis. While Applicant does not acquiesce to the particular rejection to these dependent claims, the rejection is also improper for the reasons discussed above in connection with the independent claims. These dependent claims include all of the limitations of the independent claims and any intervening claims, and recite additional features which further distinguish them from the cited reference. Therefore, the rejection of dependent Claims 2-10, 22, 24, and 25 is improper. Applicant accordingly requests that the § 102(e) rejection be withdrawn.

Regarding the § 103(a) rejection of Claims 5, 11-20, and 23, Applicant further traverses because the asserted modifications of Lewis do not overcome the above-discussed deficiencies in Lewis. For example, none of the asserted modifications to the broadcast system or alleged radio system of Lewis provide correspondence to the claimed sending of a transaction signal with the object identification through a radio system. As the asserted modifications to Lewis fail to provide correspondence to limitations absent from Lewis, the modified teachings of Lewis still fail to correspond to each of the claimed limitations thereby rendering the rejection of Claims 5, 11-20, and 23 improper. Applicant accordingly requests that the rejection be withdrawn.

With particular respect to the comments regarding the newly-cited Stetzler and Robinson at pages 7-9, it is noted that several of the comments are unrelated to the claimed invention or inaccurate. For example, at page seven, it is asserted that “Lewis fails to disclose the radio system is an RDS broadcast”. However, as discussed above, a radio system and a broadcast system are separate systems and the claimed radio system would not deal with an RDS broadcast. Also, at page 8, the assertion that Robinson teaches receiving both a radio broadcast and a URL fails to correspond to a user terminal that receives an object identification from a broadcast system and an object from a radio system. Moreover, the assertion at page 9 that Figs. 7A&B of Stetzler disclose a base station is incorrect. In contrast, Figs. 7A&B describe transmitter units A, B, and C which broadcast to receivers, which are not user terminals of a radio system. Thus, the newly-cited references have not

been shown to correspond to several of the claimed limitations and do not overcome the limitations absent from Lewis. Without a presentation of correspondence to each of the claimed limitations, the § 103(a) rejection is improper, and Applicant requests that it be withdrawn.

It should also be noted that Applicant does not acquiesce to the Examiner's statements or conclusions concerning what would have been obvious to one of ordinary skill in the art, obvious design choices, common knowledge at the time of Applicant's invention, officially noticed facts, and the like. Applicant reserves the right to address in detail the Examiner's characterizations, conclusions, and rejections in future prosecution.

Authorization is given to charge Deposit Account No. 50-3581 (KOLS.155US) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

HOLLINGSWORTH & FUNK, LLC
8009 34th Avenue South, Suite 125
Minneapolis, MN 55425
952.854.2700

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By: /Erin M. Nichols/

Erin M. Nichols
Reg. No. 57,125